



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,291	03/01/2004	G. Barrie Kitto	CLFR:232US	9495

7590 05/02/2007
David L. Parker
FULBRIGHT & JAWORSKI L.L.P.
600 Congress Avenue
Suite 2400
Austin, TX 78701

EXAMINER

WORLEY, CATHY KINGDON

ART UNIT	PAPER NUMBER
----------	--------------

1638

MAIL DATE	DELIVERY MODE
-----------	---------------

05/02/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	10/790,291	KITTO ET AL.	
	Examiner	Art Unit	
	Cathy K. Worley	1638	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 April 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.
- NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): Rejection of claims 1 and 6 under 35 USC 102(e) over Kirk et al.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 1, 3-6, and 16-17.
- Claim(s) withdrawn from consideration: 7-15.

AFFIDAVIT OR OTHER EVIDENCE

8. ☒ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☒ Other: See Continuation Sheet.

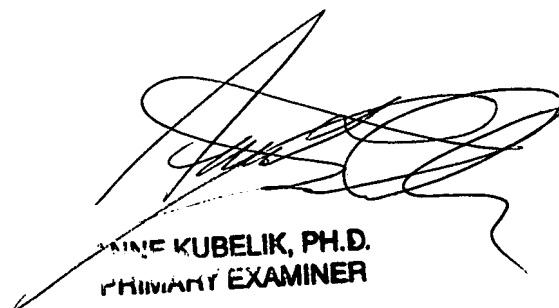
Continuation of 11. does NOT place the application in condition for allowance because: Claims 1 and 3-6 remain rejected under 35 USC 103(a) as unpatentable over Bleil et al. in view of Goldberg et al. The applicant's arguments were fully considered but were not found to be persuasive. The Applicant argues that one would not have an expectation of success and therefore the combination of references is based on an "obvious to try" rationale (see third paragraph on page 6 of the response). This is not persuasive, however, because Bleil et al. teach that orally administered gamete-specific vaccines elicit mucosal immune responses (see second paragraph on page 1) and Bleil et al. recite several references in which orally administered vaccines for immunocontraception have been successful (see second paragraph on page 1). Furthermore, Golderberg et al. teach that there are highly antigenic peptides within LDH-C4 (see abstract and page 396, second paragraph). Given the successes taught by Bleil et al. and Goldberg et al., one would have an expectation of success in combining the teachings.

The Applicant further argues that there is uncertainty in the art regarding immune responses to orally administered proteins or peptides (see paragraph bridging pages 6-7 of the response). However the Applicant relies on evidence that is not entered or considered because they did not show good and sufficient reasons was it was not earlier presented.

The Applicant further argues that they have taught a new property which demonstrates nonobviousness (see second paragraph on page 7 of the response). This is not persuasive, however, because the property demonstrated is the property that Goldberg and Bleil taught. Therefore the property is exactly what one of ordinary skill in the art would have expected from combining Bleil et al. with Goldberg et al.

The Applicant argues that Bleil et al. focus on the sp56 protein, and therefore teach away from using other antigens (see page 8 of the response). This is not persuasive, however, because Bleil et al. do not make any statements about other proteins or antigens being unsuitable for use as an immunocontraceptive; therefore, in combination with the teaching of Goldberg et al., one of ordinary skill in the art would be motivated to utilize LDH-C4 in the method taught by Bleil et al.

Continuation of 13. Other: This application contains claims 7-15 drawn to an invention nonelected without traverse in the response filed May 8, 2006. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144). See MPEP § 821.01 .



ANNE KUBELIK, PH.D.
PRIMARY EXAMINER